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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LEE, DIANE I

ART UNIT PAPER NUMBER

2876

DATE MAILED: 12/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/331,674

Examiner

Diane I. Lee

Applicant(s)

BRUGOT ET AL.

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 4/14/00 and 12/27/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-4, 6, 7 and 9 is/are rejected.
- 7) ☐ Claim(s) 5, 8 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1 ☐ Certified copies of the priority documents have been received.
- 2 ☐ Certified copies of the priority documents have been received in Application No. _____.
- 3 ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2876

DETAILED ACTION

1. Claims 1-10 are presented for examination.
2. Receipt is acknowledged of the first Preliminary Amendment filed 14 April 2000.
3. Receipt is acknowledged of the second Preliminary Amendment filed 27 December 2000.

Priority

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

5. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Specification

6. The abstract of the disclosure is objected to because of the following(s):
 - (a) Line 1: "The invention concerns" should be deleted.

Correction is required. See MPEP § 608.01(b).

7. The disclosure is objected to because of the following informalities:
 - (a) Page 4: Delete extra spaces.

Appropriate correction is required.

Claim Objections

8. Claims 1, 2, and 9 are objected to because of the following informalities:

Art Unit: 2876

- (a) Re claim 1, line 1: "the manufacture" should be changed to --a manufacture--;
- (b) Re claim 1, line 5: "its orientation" should be changed to --its orientation of the coded part--;
- (c) Re claim 1, line 6: "the reading device" should be changed to --a reading device--;
- (d) Re claim 1, line 13: "this image" should be changed to --this image on the screen--;
- (e) Re claim 2, line 2: "the device" should be changed to --a device--;
- (f) Re claim 9, line 1: "the images" should be changed to --images--; and
- (g) Re claim 9, line 3: "it" should be changed to --the marking process--.

(h) Re claim 9: claim 9 is further objected by the examiner. Claim 1 is directed to process for a manufacture working of images. Claim 9 is directed to process for marking products using the images produced according to claims 1 or 2. Is applicant intended to further limit the process for a manufacture working of images in claim 9 by making products?. For examining purpose, the examiner treated the claim 9 as a dependent claim.

Appropriate correction is required.

9. Due to the numerous claim objections as set forth above, the Applicant's cooperation is requested in reviewing and correcting the claims to place the claims in better form.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims, 1, 3, 4, 9, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 2876

(a) Regarding claims 1, 9, and 10: the phrase **"for example"** renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

(b) Regarding claims 3 and 4: the phrase **"such as"** renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Therefore, claims 1, 3-4, 9-10, and claims depend therefrom, i.e., claims 2 and 5-8, are indefinite.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(e) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claim 1-4, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krietemeier et al. [US 4,763,928-referred as Krietemeier].

Art Unit: 2876

Re claims 1, 3-4, and 9: Krietemeier teaches a process of identification having an image that includes at least one coded part undetectable by the naked eye which is capable of being read by a reading device, comprising:

generating numerical data corresponding to a particular (see col. 8, lines 60+ and figure 10, step 82);

these numerical data are converted by a suitable device into a visually exploitable and transitory on screen image, e.g., displayed on a small cathode ray tube (see col. 10, lines 11+ and figure 10, steps 88 and 90);

this image is transferred to a physical support, i.e., the display is then formatted and photographically reproduced and transferred onto a synthetic film (i.e., the image is transferred to a support such as a microfilm by photocomposition) (see col. 9, lines 17+ and figure 10, step 92);

affixing (i.e., by apply backing adhesive) one or more images thus produced to the product or article to be marked (see col. 6, line 55-col. 7, line 29 for example);

reading the code with a matrix camera (not specifically shown) and storing them in memory (see figure 10, step 84);

wherein the text of the code undetectable by the naked eye of this image is presented in the form of a dot code (see col. 7, line 33+, 53+; col. 8, lines 35+; figure 5 for example)

Although the identification process obviously includes the reading the data and comparing the data with the stored information, Krietemeier is silent with respect the data generated in an algorithmic manner by a computer program and specific steps of reading during the identification and comparing by means of a consultation node.

Due to the fact that Krietemeier teaches the process of generating numerical data corresponding to a particular, and this generating process obviously done by a computer program and wherein the computer program is a software having a coded instruction or procedure to execute a specific command

Art Unit: 2876

having a logic, which obviously teaches that the computer program having an algorithmic logic. Further, Krietemeier shows the step of identifying the article as designated at 52 in figure 6, which obviously teaches that the identification and comparing operation are performed a specific point of operation (i.e., by a means of a consultation node).

Accordingly, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to recognized that the data would have been generated in a algorithmic manner by a computer program in order to carry out the operations in sequence and the identification/comparing operation are performed a specific designated point of operation in order to facilitate the identification service.

Re claim 2: wherein the device converting numerical data into image exploitable visually on a cathode screen is an apparatus used to produce microforms as computer output (see col. 8, lines 50+); and

Re claim 6: the physical support is constituted by the product to be marked (see col. 2, lines 20+ and col. 3, lines 21+).

Re claim 7: the fact that the micro-identifier contains owner-identifying encoded data and is selected combination of serial number, dot pattern, or owner's name. Therefore, the identifier can be variable and non-variable (i.e., identical to one another or identical on each image) (see col. 4, lines 6+

Allowable Subject Matter

15. Claims 5, 8, and 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

16. The following is a statement of reasons for the indication of allowable subject matter: the best prior art of the record, Krietemeier fails to teach the specific steps of transferring the code as tone on tone to the support, placing a mask in from of the cathode screen at least one of the visible parts of the label.

Art Unit: 2876

and fitting of the image is replaced by the use of the latter as a mask to engrave the product to be marked.
as set forth in the claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane I. Lee whose telephone number is 703-306-3427. The examiner can normally be reached on Monday through Friday from 6:30 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



Diane I. Lee
Primary Examiner
Art Unit 2876

December 2, 2002